

PTO Form 1830 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77545244
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	<p>In response to the communication mailed June 26, 2009, please enter this Amendment to the identification of the goods and services and reconsider this application in view of the amendments and the remarks provided herein.</p> <p>Applicant expresses appreciation for the guidance provided in the Office Action regarding the identification of the goods. Applicant respectfully requests that the above amendment to the identification of the goods be entered after final because the identification of the goods has been amended according to the suggestions made by the Examining Attorney in the Office Action to reflect terminology used in the marketplace, to be acceptably definite, and to satisfy the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the identification of the goods in this application.</p> <p>Registration for the applicant's mark SECUREMATICS ("Proposed Mark") was refused in the recent Final Office Action under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In particular, the Examining Attorney maintained that the Proposed Mark so resembles the mark in U.S. Registration No. 2850201 ("Registered Mark"), that registration of the Proposed Mark was refused because of an alleged likelihood of confusion. In refusing registration, the Examining Attorney found the following du Pont factors as the most relevant to the case at hand: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. The applicant agrees that these three factors identified by the Examining Attorney are likely the most relevant of the du Pont factors. However, the applicant disagrees that these three factors demonstrate a likelihood of confusion, especially in light of the clarifying amendments to the identification of the goods of the Proposed Mark made herein. For at least the reasons stated below, there is no likelihood of confusion between the marks.</p> <p>In regard to the similarity of the marks, the applicant concedes that the Proposed Mark and the Registered Mark are similar in their appearance and sound as asserted by the Examining Attorney. However, even a mark that is somewhat similar to a registered mark is entitled to registration if an analysis of the other du Pont factors demonstrate that no likelihood of confusion would occur. As stated in the TMEP, "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is</p>

not likely." TMEP 1207.01(a)(I). As will be shown below, both the goods and the trade channels of the Proposed Mark and the Registered Mark are dissimilar such that no likelihood of confusion will occur.

In regard to the dissimilarity of the goods, the applicant first notes that the goods of the Registered Mark are very narrowly defined and relate to devices for monitoring and safeguarding residential and commercial structures from unwanted "physical" intrusions by people. The goods of the Registered Mark would most likely be installed into a commercial or residential structure to control access to the interior of these structures and to monitor the interior of these structures with surveillance devices once access has been granted. On the other hand, the goods of the applicant's Proposed Mark, (as further clarified by the amendment to the identification of goods and services), have nothing to do with monitoring and safeguarding residential and commercial structures. Instead, the goods of the Proposed Mark are related to protecting computer networking products and solutions from "virtual" intrusions (e.g., over a communications network), as opposed to protecting "physical" premises from unwanted "physical" intrusions (e.g., by people trying to trespass on private property). For example, an operator of a computer network, such as a proprietary computer network of a business, may employ the applicant's goods to mitigate risks associated with connecting and delivering critical computer network services to its employees and customers. Therefore, Applicant submits that the goods of the Proposed Mark (as further clarified by this amendment) and the Registered Mark are sufficiently unrelated such that no likelihood of confusion occurs and as alluded to in the voice mail the Examining Attorney left for the undersigned on June 22, 2009.

Moreover, Applicant's above arguments are bolstered by registrant's admissions and characterizations of its own goods in previous office action responses submitted by registrant. In an office action dated December 16, 2002, registrant's mark "SECURMATIC" was refused registration under Section 2(d) in view of the mark "SECUROMATIC" used in connection with a "rotary bank depository" (U.S. Registration No. 0991938). In response to this 2(d) refusal office action, (dated June 16, 2003), Registrant amended its identification of the goods to narrow its scope and then argued:

The differences between these goods and services are readily apparent. The goods and services intended to be offered under Applicant's mark are, generally speaking, surveillance and security equipment for use in providing supervisory security to entire rooms and objects contained therein, such as in a museum. Conversely, Registrant's goods are after-hour depositories for banks, that may include security devices, but such components are merely part of the structure of the good itself, and prevent tampering with the depository.

Further, the subscribers and purchasers of Applicant's goods and services and the purchasers of the services offered under the prior pending application are likely to be discerning and are not buying on "impulse." Accordingly, confusion as to the source of Applicant's goods and the goods of the Registrant is not likely. Customers purchase specialized goods and services such as those of Applicant and Registrant with deliberation and only after investigation to determine the suitability of those goods for specific needs. Under these circumstances, it is inconceivable that such a sophisticated purchaser would confuse the goods and services of the Applicant with the services of the registration, and vice versa.

Registrant's arguments were found persuasive and the Examining Attorney found that not no likelihood of confusion existed between Registrants devices for monitoring and safeguarding residential and commercial structures from unwanted "physical" intrusions by people and SECUROMATIC's devices for monitoring and safeguarding after-hour bank depositories from unwanted "physical" intrusions by people.

Applicant respectfully submits that if Registrant's goods for safeguarding against "physical" intrusions was not found to be confusingly similar to SECUROMATIC's goods for safeguarding against "physical" intrusions (which are much more closely related goods), then it logically follows that Applicant's goods, which guard against "virtual" intrusions over a computer network, (which are much, much less closely related to Registrant's goods) should also be deemed to be not confusingly similar to registrant's goods. Therefore, Applicant respectfully requests withdrawal of the 2(d) refusal to register in view of the above admissions by Registrant.

Furthermore, in regard to the dissimilarity of the trade channels, the applicant first notes that the goods of the Registered Mark most likely travel in those trade channels that are directed to owners, operators, designers, builders, and managers of commercial and residential structures. The goods of the Proposed Mark (as amended), in contrast, would travel through those channels of trade directed to computer network administrators, IT personnel, and/or IT business managers. The applicant submits that these channels of trade are mutually exclusive of each other such the goods of the Proposed Mark and the goods of the Registered Mark would not be encountered in a manner to allow any likelihood of confusion. This face has been made clear in the present application by amending the identification of goods to recite that the goods are "primarily directed to consumers of computer network security products."

Based upon the above, the applicant respectfully submits that there would be no likelihood of confusion between the applicant's Proposed Mark and the cited Registered Mark. In particular, even though the marks themselves may be similar, the dissimilarity in the goods and the channels of trade overwhelming support a finding that no likelihood of confusion would occur between the Proposed Mark and the Registered Mark.

Applicant believes the above amendment to the identification of the goods should be entered after final because the identification of the goods has been amended according to the suggestions made by the Examining Attorney in the Office Action such that no likelihood of confusion exists between Applicant's goods/trade channels and registrant's goods/trade channels.

Applicant has filed a Notice of Appeal simultaneously herewith.

Applicant respectfully submits that registration on the Principal Register is appropriate. If any impediment to passing this mark onto publication remains after entry of this Amendment and consideration of these remarks, the Examining Attorney is invited to initiate a telephone interview with the attorney of record.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	009
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DESCRIPTION

Audio and video recordings featuring information on protecting computer networking products and solutions; downloadable electronic publications, namely, electronic publications in the field of protecting computer networking products and solutions; downloadable electronic magazines, books, newsletters, user guides, fact sheets, booklets, and information circulars in the field of protecting computer networking products and solutions; computer hardware and computer software for protecting computer networking and solutions; computer accessories, namely, computer accessories for protecting computer networking products and solutions; electronic devices, namely, computer networking platforms and switches

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
DESCRIPTION	
<p>Audio and video recordings featuring information on protecting computer networking products and solutions; downloadable electronic publications, namely, electronic web pages, electronic books, electronic magazines, electronic brochures, electronic manuals, electronic instructional material, electronic user guides, electronic fact sheets, electronic booklets, and electronic information circulars in the field of protecting computer networking products and solutions; computer hardware, computer software, computer accessories, network security appliances and management software, namely, firewall computer hardware, software, accessories, and appliances intrusion detection and prevention computer hardware, software, accessories, and appliances, spam filtering computer hardware, software, accessories, and appliances, gateway antivirus and malware protection computer hardware, software, accessories, and appliances, end-point security computer hardware, software, accessories, and appliances, email and web security computer computer hardware, software, accessories, and appliances, and virtual private network computer hardware, software, accessories, and appliances for protecting computer networking products and solutions; electronic devices, namely, computer networking platforms, network security appliances, switches, routers, application acceleration devices, wireless local area network devices, domain name system and dynamic host configuration protocol management devices, and data back-up devices; all of the foregoing directed primarily to consumers of computer network security products.</p>	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Grant R. Clayton/
SIGNATORY'S NAME	Grant R. Clayton
SIGNATORY'S POSITION	Attorney of Record, Utah Bar Member
DATE SIGNED	12/28/2009
RESPONSE SIGNATURE	/Grant R. Clayton/
SIGNATORY'S NAME	Grant R. Clayton
SIGNATORY'S POSITION	Attorney of Record, Utah Bar Member
DATE SIGNED	12/28/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Dec 28 19:40:11 EST 2009
	USPTO/RF-69.27.10.50-200 91228194011225407-7754524

TEAS STAMP

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PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action**To the Commissioner for Trademarks:**

Application serial no. **77545244** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In response to the communication mailed June 26, 2009, please enter this Amendment to the identification of the goods and services and reconsider this application in view of the amendments and the remarks provided herein.

Applicant expresses appreciation for the guidance provided in the Office Action regarding the identification of the goods. Applicant respectfully requests that the above amendment to the identification of the goods be entered after final because the identification of the goods has been amended according to the suggestions made by the Examining Attorney in the Office Action to reflect terminology used in the marketplace, to be acceptably definite, and to satisfy the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the identification of the goods in this application.

Registration for the applicant's mark SECUREMATICS ("Proposed Mark") was refused in the recent Final Office Action under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In particular, the Examining Attorney maintained that the Proposed Mark so resembles the mark in U.S. Registration No. 2850201 ("Registered Mark"), that registration of the Proposed Mark was refused because of an alleged likelihood of confusion. In refusing registration, the Examining Attorney found the following du Pont factors as the most relevant to the case at hand: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. The applicant agrees that these three factors identified by the Examining Attorney are likely the most relevant of the du Pont factors. However, the applicant disagrees that these three factors demonstrate a likelihood of confusion, especially in light of the clarifying amendments to the identification of the goods of the Proposed Mark made herein. For at least the reasons stated below, there is no likelihood of confusion between the marks.

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they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP 1207.01(a)(1). As will be shown below, both the goods and the trade channels of the Proposed Mark and the Registered Mark are dissimilar such that no likelihood of confusion will occur.

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CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Audio and video recordings featuring information on protecting computer networking products and solutions; downloadable electronic publications, namely, electronic publications in the field of protecting computer networking products and solutions; downloadable electronic magazines, books, newsletters, user guides, fact sheets, booklets, and information circulars in the field of protecting computer networking products and solutions; computer hardware and computer software for protecting computer networking and solutions; computer accessories, namely, computer accessories for protecting computer networking products and solutions; electronic devices, namely, computer networking platforms and switches

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through

the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 009 for Audio and video recordings featuring information on protecting computer networking products and solutions; downloadable electronic publications, namely, electronic web pages, electronic books, electronic magazines, electronic brochures, electronic manuals, electronic instructional material, electronic user guides, electronic fact sheets, electronic booklets, and electronic information circulars in the field of protecting computer networking products and solutions; computer hardware, computer software, computer accessories, network security appliances and management software, namely, firewall computer hardware, software, accessories, and appliances intrusion detection and prevention computer hardware, software, accessories, and appliances, spam filtering computer hardware, software, accessories, and appliances, gateway antivirus and malware protection computer hardware, software, accessories, and appliances, end-point security computer hardware, software, accessories, and appliances, email and web security computer computer hardware, software, accessories, and appliances, and virtual private network computer hardware, software, accessories, and appliances for protecting computer networking products and solutions; electronic devices, namely, computer networking platforms, network security appliances, switches, routers, application acceleration devices, wireless local area network devices, domain name system and dynamic host configuration protocol management devices, and data back-up devices; all of the foregoing directed primarily to consumers of computer network security products.

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 244. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Grant R. Clayton/ Date: 12/28/2009

Signatory's Name: Grant R. Clayton

Signatory's Position: Attorney of Record, Utah Bar Member

Request for Reconsideration Signature

Signature: /Grant R. Clayton/ **Date:** 12/28/2009

Signatory's Name: Grant R. Clayton

Signatory's Position: Attorney of Record, Utah Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77545244

Internet Transmission Date: Mon Dec 28 19:40:11 EST 2009

TEAS Stamp: USPTO/RFR-69.27.10.50-200912281940112254

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